

REMARKS / ARGUMENTS

In response to the rejection of claims 4 and 7 under 35 USC 112, second paragraph, Applicant has cancelled claim 4 and amended claim 7 to make it dependent on claim 10. Applicant believe that the rejection is overcome by these amendments.

Claims 10, 2 and 5 were rejected under 35 USC 112, first paragraph. Applicants request reconsideration of this rejection for the reasons that follow.

The term "curative" is defined on page 5 of the specification and conforms to what the Examiner has agreed is enabled by the present specification – reduction of pulmonary hypertension in individuals with pulmonary hypertension.

Moreover, once a patient suffering from pulmonary hypertension has responded to the treatment, it is reasonable to expect continuation of the treatment will prevent a new onset or recurrence of pulmonary hypertension. This conforms to the definition of "prophylactic" on page 5 of the specification.

Therefore, although the term "treatment" is defined as embracing curative and prophylactic use of the present method, the definition of those terms makes clear that the full scope of the claim is enabled by the specification. Accordingly, Applicant requests withdrawal of the rejection of claims 10, 2 and 5 under 35 USC 112, first paragraph.

Claims 10, 2 and 5 were rejected under 35 USC 103(a) over Goncharova et al, Tanabe et al and Zimmermann et al. Applicants request reconsideration and withdrawal of this rejection for the reasons that follow.

Gonchharova et al and Tanabe et al are relied on as implicating PDGF and PDGFR in pulmonary hypertension. Zimmermann et al is relied on as disclosing that imatinib inhibits PDGFR. Thus, the Examiner formulates a hypothesis from the prior art that imatinib may have utility for treating pulmonary hypertension.

In order to reject the present claims under 35 USC 103, the Examiner must demonstrate that the skilled artisan would have a reasonable expectation of success for treating pulmonary hypertension with imatinib based on the disclosures of the prior art. Naturally, the scientist is hopeful that experiments which he or she conducts will support the hypothesis being tested and usually has some expectation that it will. Yet, there are undoubtedly experiments that fail and hypotheses which are incorrect. Whether the expectation of success is reasonable is linked to the predictability of the field of the experiment and the disclosures of the prior art. In more predictable fields, the knowledge and experience of one of ordinary skill in the art may be sufficient to permit them to predict with a reasonable level of certainty whether an experiment will be successful. However, in less predictable fields, there must be some objective teaching in the art that gives the skilled artisan a higher level of confidence for any expectation of success to be reasonable. Otherwise, the inventor's own work testing the hypothesis could, with the benefit of hindsight, be the basis a rejection under 35 USC 103.

Applicant believes that such hindsight is the basis for the present rejection. If correct, the alleged disclosures of the references may provide a basis to formulate a reasonable hypothesis relating to the use of imatinib for the treatment of pulmonary hypertension. However, Applicants assert that research in this field is highly unpredictable (as demonstrated in the enablement rejection), and the references do not provide any disclosure which would lead the skilled artisan to expect that such a hypothesis will actually turn out to be correct when subjected to experimental testing. It is the hindsight use of the present disclosure which provides the information needed for any expectation of success to be reasonable. Therefore, the rejection under 35 USC 103 is improper.

Applicant further notes that claim 4 was not included in the rejection under 35 USC 103(a). Applicant further submits that the rejection is overcome by incorporating the limits of claim 4 into claim 10.

Applicants request withdrawal of the rejection of claims 10, 2 and 5 under 35 USC 103(a) for the reasons discussed above.

Entry of this amendment and reconsideration and allowance of the claims are respectfully requested.

Respectfully submitted,



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